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D E C I S I O N
of 23 September 2004

Case Number: T 0797/02 - 3.4.2

Application Number: 97200955.9

Publication Number: 0806701

IPC: G02F 1/136

Language of the proceedings: EN

Title of invention:
Liquid crystal device

Applicant:
SEIKO EPSON CORPORATION

Opponent:
-

Headword:
Divisional of divisional

Relevant legal provisions:
EPC Art. 76
EPC R. 25

Keyword:
"Subject-matter extending beyond the content of the earlier divisional application (yes)"

Decisions cited:
T 0260/85, T 0331/87, T 0514/88, T 0441/92, T 1158/01

Catchword:
The invention or groups of inventions defined in the claims of the parent application as divided out of the grandparent application determines the essential content of the parent application. To meet the requirements of Article 76 EPC any further divisional applications divided out of the parent application must be directed to objects encompassed by such invention or group of inventions.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0797/02 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal
of 23 September 2004

Appellant: SEIKO EPSON CORPORATION
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Tokyo (JP)

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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 3 January 2002 refusing European application No. 97200955.9 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: A. G. Klein
Members: A. G. M. Maaswinkel
C. Rennie-Smith

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal, received on 22 February 2002, against the decision of the examining division, dispatched on 3 January 2002, refusing the European patent application No. 97200955.9. This patent application had been filed as a divisional application of European patent application No. 94106661.5 (publication No. 0 609 919) which will be referred to hereafter as the **parent application**. This parent application had itself been filed as a divisional application of European patent application No. 89304929.6 (publication number 0 342 925) which will be referred to hereafter as the **grandparent application**. The fee for the appeal was paid on 22 February 2002. The statement setting out the grounds of appeal was received on 1 May 2002.

II. In its decision, the examining division held that the divisional application under examination did not meet the requirements of Article 76(1) EPC. In particular it was of the opinion that Claim 1 lacked the essential feature that the thin film transistors (TFTs) in the gate or source drive line circuit have a gate length shorter than that of the TFTs of the picture element matrix, which caused the claim to define subject-matter which was not unambiguously derivable from the parent application as filed.

III. In a communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal sent on 12 July 2004, the board noted that an important aspect in the present case seemed not to have received adequate attention so far, namely that the parent

application was not a genuine first application but a divisional application of the grandparent application. The board in particular questioned whether any subject-matter not included in a divisional application by way of division from a still earlier application could nevertheless be made the object of a further division of that divisional application. In its view, such subject-matter being an object of the very first application only, it could only have been divided out from that first application.

IV. On 23 September 2004 oral proceedings were held. At the oral proceedings the appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of Claims 1 to 9 filed with its letter of 20 April 2000 (main request); as an auxiliary request it requested further to refer to the Enlarged Board of Appeal a question filed during the oral proceedings.

V. Claim 1 of the main request reads as follows:

"An active matrix panel comprising a picture element matrix (22), which is mounted on a transparent substrate (71, 86) and which includes a plurality of gate lines (24, 25), a plurality of source lines (26, 27, 28) and a plurality of picture elements (32, 33), each of the picture elements including a thin film transistor (29, 101), the active matrix panel further comprising a gate line drive circuit (21) and a source line drive circuit (12); and being characterised in that at least one of the gate line drive circuit and the source line drive circuit comprises a plurality of thin film transistors (47 to 56; 58, 59; 99, 100)

provided on the transparent substrate; and in that at least one of the gate line drive circuit and the source line drive circuit comprises at least a shift register (163) having CMOS thin film transistors and sample and hold circuits, the CMOS thin film transistors including first conductive type thin film transistors and second conductive type thin film transistors, and the sample and hold circuits (166) including at least first conductive type thin film transistors, the gate length of the first conductive type thin film transistors of CMOS thin film transistors being greater than the gate length of the first conductive type thin film transistors of the sample and hold circuit (166)."

VI. The board gave its decision at the end of the oral proceedings.

VII. The arguments of the appellant may be summarised as follows.

(a) With regard to the reasoning in the decision under appeal, the appellant argued that the examining division had refused the application because in its opinion it did not meet the requirements of Article 76(1) EPC. In particular the division referred to the Statement of Invention of the parent application which (like Claim 1) reads "According to a first aspect of the present invention, there is provided an active matrix panel… being characterised in that at least one of the gate line drive circuit and the source line drive circuit comprises a plurality of complementary thin film transistors provided on the transparent substrate having a gate length shorter than that of the thin film transistors of the picture element matrix."

Claim 1 of the present application did not include these features of the characterising portion which were considered essential to the invention, and its omission was therefore objectionable under Article 76(1) EPC. However, this article stipulates that a divisional application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed". According to the established case law of the boards of appeal, the "content" of an application is not limited to the subject-matter claimed therein but means the total information content of the disclosure, see the decisions T 260/85, T 441/92 and in particular point 2.2 of the Reasons of T 514/88. Furthermore the mere inclusion of a feature in a statement of invention cannot definitely determine that this feature is essential, since the statement is merely a consistory clause and it may, as may also an independent claim, contain inessential features, see the decision T 331/87.

With respect to the feature that the drive circuit transistors have a gate length shorter than the gate length of the picture element matrix transistors, reference is made to page 8, lines 44 to 49 of the published parent application where four basic criteria for the preferred drive circuit are summarised, none of which include this gate length feature. In fact, the only passages in the description dealing with this feature are the numerical values in Table 2 (page 8 of the published parent application) and the fourth benefit/advantage listed on page 12, starting at line 57, of the published parent application. The values in Table 2 are explicitly stated to relate to an "example". Also, from the very wording of the fourth

"benefit" or "advantage" it is evident that this does and cannot define an essential feature, in contrast to the previously cited four "basic criteria".

Therefore, considering the total information content of disclosure in the parent application, it is evident that the skilled person would not consider the features objected to to be essential. Furthermore, the requirement of Article 76(1) is not whether or not the content of two applications is identical but only whether or not the content of the divisional extends beyond that of the earlier filed application.

(b) As regards the fact, emphasized by the board in its communication of 12 July 2004, that the patent application at issue had been divided out of a parent application which itself had been filed as a divisional application of the grandparent application, the appellant submitted the following arguments.

As explained in the decision T 441/92, see point 4.1 of the Reasons, "…once a divisional application has been validly filed, it becomes separate and independent from the parent application. Thus, once the conditions of Article 76(1) have been met, the divisional application is to be examined as an application quite separate from the parent application and must itself comply independently with all the various requirements of the EPC." This is also in line with the decision T 1008/99, see point 2.2 of the Reasons. Therefore, applying this principle to the case of cascading divisionals, as soon as the first (parent) divisional of the grandparent application is validly filed it becomes a quite separate application from the grandparent application,

and a subsequently filed divisional application of the parent application (child application) should be treated according to the same principles as the first divisional application. It is also noted that Article 76(3) EPC stipulates that all special conditions to be complied with by a divisional application are laid down in the Implementing Regulations. Therefore, should there exist any particular provisions regarding cascading divisional applications, these should have been defined in the Implementing Regulations to the EPC, which is not the case.

The appellant also referred to the hypothetical case of a grandparent application originally disclosing and claiming three inventions "A", "B" and "C" respectively, but in which only invention "A" is claimed. In a first generation divisional (parent) filed with the identical specification as the grandparent application invention "B" is claimed. The question raised by the board in its communication of 12 July 2004 amounts to whether it was possible to file a further divisional application, the "child" application divided out of the "parent", having the same specification as both the grandparent and the parent applications but claiming invention "C". If that question were to be answered in the negative, serious difficulties would arise in the assessment of divisional applications for the requirements of Article 76(1) EPC which, according to established case law of the boards of appeal, was equivalent to the examination under Article 123(2) EPC, see decisions T 514/88, point 2.1 and 2.2 of the Reasons and T 441/92, point 4.3 of the Reasons.

Accordingly if, apart from the independent claims and the consistory clause in the statements of the invention, the documents of the grandparent, parent and child applications are identical, the total "content" of the cascading divisional applications is the same and they must therefore be considered as having been validly filed under Article 76(1) EPC.

Furthermore, an objection that by filing cascading divisional applications members of the public might be prejudiced is not justified, since the provisions of Article 123(2) EPC already guarantee that an applicant cannot obtain an unwarranted protection, as is explained in point 4.7 of the Reasons in the decision T 441/92: "Interested members of the public are put on notice by the EPC that, after a European patent application has been filed, the content of that application cannot thereafter be extended, but that, nevertheless, while the application is pending, the protection sought by the claims may be extended beyond that sought in the claims as originally filed. The public are informed as to the content of the application as filed when the application is published (see Article 93(2) EPC). In this respect, there is no distinction between a normal application and a divisional application."

Should the board therefore consider deviating from the previous practice, the appellant requested the board to refer the following question to the Enlarged Board of Appeal:

"Where a divisional application is filed from a parent application which is "not a genuine first application" but itself is a divisional application: is there any additional criteria to be met by the second (i.e. child) divisional under Article 76 or any other provision of the EPC resulting from the fact that the parent application is itself a divisional application? That is, is there any implication from the expression "divisional application" as applied to the parent application that limits what is to be considered the content of the parent application as filed? In particular is there any consideration applying to a divisional from a divisional which breaks the Case Law supported equivalence of "content of the application as filed" in Articles 76(1) and 123(2)?"

Reasons for the Decision

1. The appeal is admissible.

2. *Compliance of the main request with the requirements of Article 76 EPC*

2.1 Claim 1 of the main request no longer comprises the features set out both in claim 1 and in the statement of invention in the description of the parent application as filed (see page 3, lines 46 to 52 of EP-A-0 609 919 as published), according to which the plurality of thin film transistors of at least one of the gate line drive circuit and the source line drive circuit have a gate length shorter than that of the thin film transistors of the picture element matrix.

The examining division considered this feature to be essential to the invention defined in the parent application and that the absence of this feature in present claim 1 resulted in its containing subject-matter which was not unambiguously derivable from the parent application.

2.2 The board notes in this respect that the parent application was itself filed as a divisional application of the grandparent application.

The board has no reservations of principle as to the admissibility of the filing of an application divided out of an earlier divisional application (see the decision T 1158/01; to be published in OJ EPO; point 3.1 of the Reasons). However, the filing of second or further generation divisionals - which might indeed occur a long time after grant or refusal of the very first application - might potentially contravene the generally acknowledged principle that the examining procedure at the EPO must be conducted in a such a way as to ensure that, within a reasonable period of time after the filing of a patent application, the public should have a fair knowledge of the extent of the exclusive rights sought by the applicant. When applying the material provisions of the EPC governing admissibility of divisional applications to the particular case - not specifically envisaged in the Convention - of applications divided out of divisional applications, care should therefore be taken not to run counter to this principle.

In the present instance, by filing the parent application as a divisional application - which, apart

from the above-mentioned adapted statement of the invention, comprised the same description as the grandparent application, together with substantially amended claims - the applicant made clear that it wished the particular invention or group of inventions he freely chose to define in these claims to be divided out of the grandparent application and to be subjected to a separate examination procedure.

Had the applicant wished to divide any other invention out of the grandparent application, it could have done so by filing corresponding divisional applications based on that grandparent within the time period set out in Rule 25 EPC: but it did not do that. The provisions of Rule 25 EPC indeed establish a point in time after which the applicant can no longer seek protection for any subject-matter disclosed but not claimed in its patent application, and these provisions therefore are of paramount importance in providing legal certainty for the public. The applicant in the present case allowed the grandparent application to proceed to grant without filing any divisional applications other than the parent application. Therefore, allowing it to divide out of the parent application subject-matter which was neither encompassed in the invention or group of inventions for which said parent application was filed nor directly divided out of the grandparent application before expiry of the time delay of Rule 25 EPC, would unacceptably deceive the legitimate expectation of the public that exclusive rights would be confined to the subject-matter of the claims granted at the outcome of the examination of the grandparent application and the subject-matter specifically divided out of the

grandparent application by way of the parent application.

To allow subject-matter from a grandparent application (which is no longer pending) which was reproduced in the description of a parent divisional application but not encompassed by the invention actually divided out of the grandparent application, to be further divided out of that parent application at a later date would be to allow applicants, by the mere filing of recurrent cascading divisional applications, to leave the public completely uncertain during most of the life of a patent as to how much of the subject-matter of the original patent application might still be claimed. This would indeed pave the way for potential misuse by applicants of the possibility afforded by the EPC to file divisional applications.

For these reasons, it is the board's view that the invention or group of inventions defined in the claims of the parent application as divided out of the grandparent application determines the essential content of the parent application; and therefore to meet the requirements of Article 76 EPC any further divisional applications divided out of the parent application must be directed to objects encompassed by such invention or group of inventions.

In the present case, the content of the parent application as actually divided out of the grandparent application is confined to an active matrix panel which - as clearly defined in the only independent claim of the parent application - *inter alia* comprises complementary thin film transistors having a gate

length shorter than that of the thin film transistors of the picture matrix. Since claim 1 of the appellant's main request does not exhibit such features, its subject-matter extends beyond the content of the parent application in contravention of the requirements of Article 76 EPC.

2.3 In support of its view that the claimed subject-matter did not extent beyond the content of the parent application, the appellant submitted that, just as for any earlier application, it was the whole description of the parent application which should be taken into account to determine the content of this application. Since the description of the parent application, which is substantially the same as that of the grandparent application, comprised several indications showing that the omitted features at issue here were not mandatory, the subject-matter of claim 1 of the main request could not possibly extend beyond the content of the parent application. The appellant in this respect cited decisions of the boards of appeal establishing that examination under Article 76 EPC is equivalent to that under Article 123(2) EPC and that a valid divisional application is to be examined as an independent application; from which it followed that in the present case the parent divisional application should be considered as if it was a normal first application when assessing whether a subsequent divisional application meets the requirements of Article 76 EPC.

The board cannot concur with the appellant's view. For reasons of convenience it is indeed common practice to allow applicants who file a divisional application to file with the divisional substantially the same

description as that of the parent application and to adapt it to the claims only during further prosecution of the divisional, where required (see Guidelines for Examination in the European Patent Office, C VI 9.1.5). Applicants cannot however be allowed thereby to benefit by using obvious inconsistencies between the claims and description of a divisional application as filed to extend unduly the definition of the subject-matter which they actually divided out of the earlier application and made the subject-matter of the divisional.

The board also notes that none of the decisions referred to by the appellant concerns or even envisages the question at issue here, namely the assessment of the content of a divisional application which can be further divided out of it by the filing of a second or subsequent divisional application.

In T 441/92, which appears to come closest to the present case, it was considered whether the whole subject-matter of a parent application could be reinstated in a divisional application filed originally for a part only of this subject-matter but with a description which, as in the present case, was substantially identical to that of the parent application with the exception of the statements of field and objects of the invention. The circumstances of this case were however very specific and significantly different from those of the present case. As a matter of fact, the parent application had lapsed following the accidental failure of the applicant to indicate in due time its approval of the text in which the examining division intended to grant the

application. The board allowed the reinstatement, thus in effect redressing the negative consequences of the accidental lapse of the parent application. However, since the lapse of the parent application was accidental and followed by an appeal from the appellant, the public had probably not been reliably led to believe that the subject-matter of the parent application as later reinstated into the divisional application could be freely exploited (see point I of the Summary of Facts and Submissions and point 6 of the Reasons).

One obviously unacceptable consequence of the position argued for by the appellant would in effect be the setting up of a system of "continuation applications" as explicitly provided for in US patent law, but for which there is no basis, either explicit nor implicit, in the Convention.

Accordingly, for all the above reasons, the board does not deem it necessary in order to decide this case to refer to the Enlarged Board of Appeal the question proposed by the appellant.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

P. Martorana A. Klein